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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,524	04/09/2001	Steven J. Smith	00694001	8436

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FLIESLER MEYER, LLP
FOUR EMBARCADERO CENTER
SUITE 400
SAN FRANCISCO, CA 94111

EXAMINER

PHAM, THOMAS K

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,524

Applicant(s)

SMITH, STEVEN J.

Examiner

Thomas K Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/18/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

First Action on the Merits

1. Claims 1-20 of U.S. Application 09/829,524 filed on 04/09/2001 are presented for examination.

Quotations of U.S. Code Title 35

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim Rejections - 35 USC § 102

6. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,343,327 (“Daniels”).

Regarding claims 1 and 11

Daniels teaches transmitting electronic data messages comprising: generating a plurality of lists of mailing addresses, each of said lists containing a portion of a primary mailing list (col. 5 lines 48-55, “electronic inserter 110 ... on the same network”); transmitting separate ones of the plurality of lists or groups of the plurality of lists (col. 5 lines 48-55, “electronic inserter 110 splits ... on the same network”) to a plurality of electronic mail transmission servers (col. 6 lines 59-62, “Each electronic mail piece ... the electronic inserter 110 is executed”); and transmitting an electronic mail message with the electronic mail transmission servers to addressees contained in the lists sent to the electronic mail transmission servers (col. 6 lines 21-27, “Job setups can also ... batch of mail pieces”).

Regarding claims 2 and 12

Daniels teaches initiating a primary electronic mail transmission process in a first computer, wherein the first computer is in communication with the electronic mail transmission servers (col. 6 lines 7-15, “the job setup for... delivery mechanism, e.g. fax.”).

Regarding claims 3 and 13

Daniels teaches the first computer is a database server containing the lists of mailing addresses (col. 3 lines 26-31, “A user at a sender’s ... document in the printstream”).

Regarding claims 4 and 14

Daniels teaches verifying that an electronic mail message has been sent to each recipient set forth

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in the lists of mailing addresses (col. 4 lines 26-33, “If the electronic mail ... by physical means”).

Regarding claims 5 and 15

Daniels teaches partitioning a primary mailing list into the plurality of lists of mailing addresses (col. 5 lines 48-55, “electronic inserter 110 ... on the same network”).

Regarding claims 6 and 16

Daniels teaches designating separate receive servers for receiving any bounced messages or replies (col. 7 lines 42-57, “The interlock file 400 ... process by physical inserter 106”).

Regarding claims 7 and 17

Daniels teaches reviewing mail transmission progress information generated by the electronic mail transmission servers (col. 7 lines 21-23, “Status for each electronic ... in the interlock file 400”).

Regarding claims 8 and 18

Daniels teaches restarting any stalled process identified in said step of verifying progress (col. 7 lines 17-21, “If the electronic mail ... have been exhausted”).

Regarding claims 9 and 19

Daniels teaches automatically updating the primary mailing list based on returned mail information (col. 6 line 65 to col. 7 line 6, “The message router 112 detects ... for actual delivery”).

Regarding claims 10 and 20

Daniels teaches primary mailing list is stored at a location separated from the transmission

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servers (col. 4 lines 14-25, "The separate electronic mail ... via security module 114").

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thomas Pham*; whose telephone number is (703) 305-7587 or the new number (571) 272-3689 beginning on October 2004, Monday - Friday from 8:00 AM - 5:00 PM EST or contact Supervisor *Mr. Anthony Knight* at (703) 308-3179 (or 571 272-3687 starting Oct. 2004).


Any response to this office action should be mailed to: **Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450**. Responses may also be faxed to the **official fax number (703) 872- 9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas Pham
Patent Examiner

TP

September 3, 2004


Anthony Knight
Supervisory Patent Examiner
Group 3600